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10/066,097	01/31/2002	Meichun Hsu	10007908-1	6024

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/066,097	Applicant(s) HSU ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-16 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-16 and 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see paper, filed 5/24/07, with respect to the 103 rejections of claims 1, 3-10, 21-26 (method), 11, 13-16, 18-20, 27-28 (apparatus) over AAPA / www.google.com have been fully considered and are persuasive. The rejections of these claims has been withdrawn.

Claim Rejections - 35 USC § 112

2. Claims 1, 3-10, 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the preamble calls for "A method for publication and discovery of e-services "information"" but there is no discussion with respect to "publication" of the "e-services information" in the body of the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

As of 5/24/07, independent method claim 1 is as followed:

1. (Previously Presented) A method for publication and discovery of e-services provided by service provider organizations, the method executable in a system associated with a client organization and that includes a discovery agent and a client agent, the method comprising:

(a) employing, by the system, the discovery agent to find one or more prospective e-services based on one or more search parameters, wherein e-services are published by corresponding service provider organizations in respective e-service descriptions, and wherein finding the one or more prospective e-services comprises matching the one or more search parameters with the published e-service descriptions;
and

(b) utilizing, by the system, the client agent to connect to the one or more prospective e-services by employing a protocol that is supported by the one or more service provider organizations providing the one or more prospective e-services.

Note: for convenience, letters (a)-(b) are added to the beginning of each step.

From the Webster's dictionary, in step (a), the term "employing" merely means: "to make use of, use", "to engage the services or labor of for pay", or "hire". Also, the term "utilizing" in step (b) merely means: "to put to use" or "use". Note that the phrases "...to find one or more ...published e-service description" in step (a) and "... to connect ...prospective e-service" in step (b) are considered as "intent/intention to be used" or "intended use" and thus carrying no patentable weight in a method claim. Since in a Method claim, only positive or active method step, i.e. "verb+ing" such as "finding one or more prospective e-services based on one or more search parameters using the discovery agent", or "connecting to the one or more prospective e-services using the client agent ..." receive patentable weight since they indicate that the actions are actually carried out and not merely "intention to be used".

Note that the claimed invention is generally about "data processing" and the term such as "e-services" is merely refers to the function or "name" of the information or data stored on a database, i.e. the data is about "e-service of an organization". However, the function or name or intended use of the data is considered as "non-functional" descriptive material and receive no patentable weight.

Therefore, claim 1 can be basically summarized as below:

1. A method for publication and discovery of information/data about e-services provided by service provider organizations, the method executable in a system associated with a client organization and that includes a module called "discovery agent" and another module called "client agent", the method comprising:

(a) employing (engaging the service), by the system, the 1st module called "discovery agent" with the intention of "to find one or more prospective e-services based on one or more search parameters, wherein e-services are published by corresponding service provider organizations in respective e-service descriptions, and wherein finding the one or more prospective e-services comprises matching the one or more search parameters with the published e-service descriptions"; and

(b) utilizing (using or putting to use), by the system, the 2nd module called "client agent" with the intention of "to connect to the one or more prospective e-services by employing a protocol that is supported by the one or more service provider organizations providing the one or more prospective e-services".

Again, term such as "e-services" is merely refers to the function or intended use of the information or data stored on a database. The function or intended use or name of the data is considered as "non-functional" descriptive material and receive no patentable weight. Similarly, the term "service provider organization" or "client organization" are also considered as non-functional" descriptive material and receive no patentable weight.

Similary, www.google.com discloses a method for discovering of information/data about organizations, the method executable in a system associated with a client organization and that includes a module called "discovery agent" and another module called "client agent", the method comprising:

(a) employing (engaging the service), by the system, the 1st module called "discovery agent" with the intention of to find information/data; and

{see pages 9-11, "seaching to find results" "... your site search results..."}.

As for the name of "discovery agent", this is inherently included in the teaching of www.google.com since it carries out the same activity of "finding or searching information to find the result".

(b) utilizing (using or putting to use), by the system, the 2nd module called "client agent" with the intention of to connect to a activity/service.

{see page 10, see "Cached pages and highlighted terms", and "... users can access that webpage even if the hosting server is busy or down. The queried term is highlighted to make location the term fast and easy"}.

Surely there is teaching about "connection" or "accessing" another feature on the search results. As for the name of "client agent", this is inherently included in the teaching of www.google.com since it carries out the result of "connecting" to another feature on the search result webpage.

Www.google.com fairly teaches the claimed invention except for the difference in the intention to do something after "employing" and "utilizing" and the name/function of the data, i.e. "e-service". Since they carry no patentable weight in a "data processing", it

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would have been obvious to modify the teachings of www.google.com to use the data for different function (or to call different names) in (a) or different intention to use as mere applying to other Custom's service (your site's service) if desired.

As for dep. claim 3 (part of 1 above), which deals with "accessing the information published at a website", this is taught on page 10, under "Cached pages and highlighted terms".

As for dep. claims 4-10, 21-24 (part of 1 above), which deals parameters with respect to "seach parameters", "protocol", and "matching" within the intention "to find" and "to connect", they are rejected for the same reasons set forth in the rejection of claim 1 above. Moreover, they are inherently included or fairly taught on pages 6-11 of www.google.com.

As for dep. claim 25 (part of 1 above), which deals with well known system parameters, serve that is remoted form the client organization, it's inherently included or fairly taught on pages 6-11, especially page 10 cited above, of www.google.com

As for dep. claim 26 (part of 1 above), which deals with well known search parameters, i.e. predetermined form having plural fields filed by a user, serve that is remoted form the client organization, it's inherently included or fairly taught on pages 6-11, especially page 10, of www.google.com.

As for independent system Claim 11, basically, this reads over the system to carry out the independent method claim 1 as cited above, and therefore, it's rejected over the respective system of www.google.com used to carry out the rejection of method claim 1 cited above.

As for dep. claims 13-14 (part of 11 above) which appear to be dealt with further limitation of the discovery agent and the client agent, since these are passively written "are disposed", they are interpreted as being capable of and have very little patentable weight in a system claim. Moreover, these are taught in google.com as www.google.com.

As for dep. claims 15-16 (part of 11 above) which appear to be dealt with further limitation of the discovery agent, these are taught in the searching engine of google.com as www.google.com. Moreover, the use of other well known searching units/generators would have been obvious as mere using other similar well known protocol features.

As for dep. claims 18-20, 27-28 (part of 11 above) which basically have the similar limitations as in dep. claims 7-10, 21, respectively cited above, they are rejected for similar reasons as shown in dep. claims 7-10, 21 above.

6. Claims 11, 13-16, 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of TANG et al (US Patent 5,960,173) or vice versa.

AAPA, as shown in the "Background of the Invention" on pages 2-5, discloses the current communication system of information publication, search and discovery of the information on different applications and web servers and wherein the information is about e-service of an entity such as service provider and the need for the system to be carried out using the same applications and web service so the entities involved can contact (connect) to each other using the web.

TANG et al is cited to teach the use of a Encounter Server for communicating with several entities on the web comprising a processor and Encounter Aware Application (discovery agent) to receive information about the work (or service) of an entity, store the information, monitor the service of a second entity through information or data manipulation, matching the received and monitored information to identify desired result, such as similar tasks (task proximity), and a client agent (Fig. 6, 8, 141a, 143a, "Encounter Server", "Encounter Window")) notify/connect to one or more web servers of the different entities {see Figs. 6-8, col. 3, line 25 to col. 6, line 55, col. 17, lines 50-67, col. 18, lines 1-54}. It would have been obvious to modify the communication system of AAPA of using different applications and servers to contact various entities/organizations for information publication, search and discovery with the same applications and servers so that (or for the benefit that) entities/organizations can connect to each other when the desired interest matching criteria of the different entities are met as taught by TANG et al above.

Alternatively, it would have been obvious to modify the teachings of TANG et al to include other types of information or organization entities such as e-service information as mere applying to other similar publication and discovery communication service using the same applications and web services.

As for dep. claims 13-14 (part of 11 above) which appear to be dealt with further limitation of the discovery agent and the client agent, since these are passively written "are disposed", they are interpreted as being capable of and have very little patentable weight in a system claim. Moreover, these are taught in TANG et al Figs. 1, 7-8.

As for dep. claims 15-16 (part of 11 above) which deal with well known matching elements, semantic, fuzzy logic, etc., these are inherently included in the matching engine of TANG et al as shown on Figs. 7-8, col. 14, lines 18-67, col. 17, lines 50-67 or would have been obvious to use these elements to improve matching efficiency or accuracy.

As for dep. claims 18-19, (part of 11 above) which deal with the type of web documents, i.e. ML document such as XML, this is inherently included in the web service of TANG et al as shown on Figs. 1-6, col. 11. The use of other similar or well known ML for the web would have been obvious to a skilled artisan.

As for dep. claims 20, 27-28, (part of 11 above) which deal with the type or features of the publication and discovery information about an e-service, i.e. service description, schema, price, etc., these are taught in AAPA in view of AAPA /TANG et al. Moreover, they are considered as non-functional descriptive materials, since they are merely names or functions of the stored data/information and non-functional and carry no patentable weight.

No claims are allowed.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

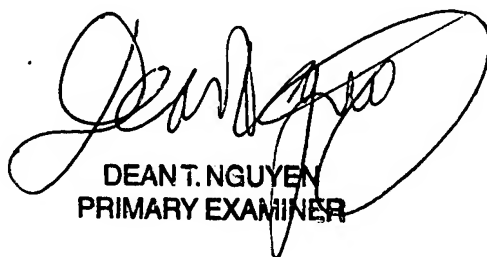
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
August 17, 2007



DEAN T. NGUYEN
PRIMARY EXAMINER